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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/731,008	12/07/2000	Mary Kay McCoy	G03.020	8773
28062	7590	04/15/2004	EXAMINER	
BUCKLEY, MASCHOFF, TALWALKAR LLC 5 ELM STREET NEW CANAAN, CT 06840			RUDY, ANDREW J	
			ART UNIT	PAPER NUMBER

3627

DATE MAILED: 04/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/731,008

Applicant(s)

MCCOY, MARY KAY

Examiner

Andrew Joseph Rudy

Art Unit

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 02 February 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 7-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 7-18 are still withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention and species, there being no allowable generic or linking claim. The previous rejection from Paper No. 7 is withdrawn pursuant to Applicant's REMARKS received February 2, 2004. The Examiner regrets the following Office Action was not presented earlier as it is his desire to achieve compact prosecution on the merits of the present Application.

### ***Claim Rejections - 35 USC §101***

2. Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim, the recited process must somehow apply, involve, use, or advance the technological arts.

In the present case, claims 1-6 only recite an abstract idea. The recited steps of inputting and deploying copies of a computer program does not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. The terms “computer program” and “inputting” and “deployed” and “interactive” and “to run” and “digital data storage media” do not obviate this line of reasoning. These steps only constitute an idea of how to use a computer program. The computer program need not be executed, and if executed may merely be given by hand (digital data) or orally, to an audit firm.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1, claim 1, “for enabling a plurality of audit firms” is intended use. These features are not positively recited and thus are not given any great degree of patentable weight. However, Applicant appears to attempt to positively recite from claim 1, line 8 “said audit firms” within the body of the method claim. As is, it is not clear what the intent and scope of the present claim language. The intended use is deemed to supercede the positive recitation for purposes of this Office Action. Similar analogy applies for the computer program recited.

Claim 1, line 14, "the respective audit firm" lacks antecedent basis and is not clear.

Claim 1, lines 18-19, "all said received respective current NOI audit reports" lacks antecedent basis and is not clear what is being referenced.

Claim 2, lines 2-3, "on said received respective NOI audit report" lacks antecedent basis and is not clear what is being referenced.

Claim 6, line 8, Applicant appears to attempt to positively recite "said audit firms" within the body of the method claim. As is, it is not clear what the intent and scope of the present claim language. Similar analogy applies for the computer program recited. The intended use from line 1 is deemed to supercede the positive recitation for purposes of this Office Action.

Claim 6, line 10, "Current" is improper syntax.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-6, as understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over the article titled "Audit fees, industry specialization, and compliance with GAAS reporting standards" (O Keefe).

O Keefe discloses having an entity using computerized audit reports associated with net operating income (NOI) associated with real-estate property transactions. O Keefe does not specifically disclose a plurality of audit firms, each operating independently of each other and having a reporting relationship with a common investment entity.

Official Notice is taken that an entity using a plurality of audit firms, e.g. a Big 8 (now informally known as the Big 6 accounting firms) each operating independently of each other and having a reporting relationship with a common investment entity were common knowledge in the art prior to Applicant's filing date, as were underwriting and summary reports.

To have provided a plurality of audit firms, each operating independently of each other and having a reporting relationship with a common investment entity for O Keefe would have been obvious to one of ordinary skill in the art in view of Official Notice. The motivation for having done such would have been to incorporate common knowledge and extremely well known integrity of reporting data to investors or a regulation authority, to ensue that the data is accurate. It is noted that Applicant's intended use, e.g. for enabling, do not positively recite claim limitations that are given great patentable weight.

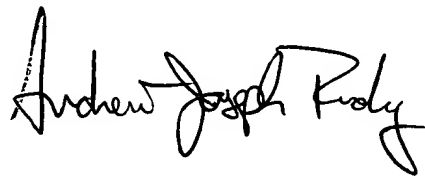
7. Further pertinent references of interest are noted on the attached PTO-892.

*Conclusion*

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew Joseph Rudy whose telephone number is 703-308-7808. The examiner can normally be reached on Tuesday thru Friday, 7:30 a.m until 6 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Robert Olszewski can be reached on (703) 308-5183. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, reading "Andrew Joseph Rudy". The signature is written in a cursive, flowing style. Below the signature, there is a single diagonal tick mark.